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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT BRUYNESTEYN

Appeal 2009-0199
Application 10/723,392
Technology Center 1700

Oral Hearing Held: February 11, 2009

Before BRADLEY R. GARRIS , LINDA M. GAUDETTE , and
MARK NAGUMO, Administrative Patent Judges.

ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for hearing on Wednesday,
2 February 11, 2009, commencing at 8:57 a.m., at the U.S. Patent &
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Christine
4 L. Loeser, Notary Public.

5 MR. POSA: Thank you. And thank you for using this
6 particular mode of communication. It's kind of fun. I have done it before.

7 As you know, today's topic is the extraction of metals from ores
8 using bacteria to create acid which provides a leaching function.

9 The case on appeal here has two independent claims, namely 1
10 and 14, and what I'm going to argue and what has been argued in the record
11 is that Appellant's process clearly involves two steps to carry out this
12 process.

13 The specification is replete with references to this two-step
14 process, and in fact, an important point of novelty has to do with this
15 preconditioning step which I'm sure we will talk a lot about.

16 All of the claims on appeal here stand rejected over two
17 references, namely, this Duyvesteyn U.S. patent and this statutory invention
18 registration. There is also a 112 first paragraph rejection which I will get to
19 later because it's important in this case.

20 I want you to -- first of all, Appellant is well aware of
21 references such as these, and you probably noticed that the statutory
22 invention registration was, in fact, mentioned in the background of the
23 invention, and in fact, some of these curves presented in the specification
24 have to do with the improved leaching process that can be obtained with this
25 two-step method.

26 So anyway, in fact, some of those curves are taken directly

1 from references such as these, and as far as this two-step method is
2 concerned, it's our position that an unexpected result was, in fact, obtained.
3 This is not a brand-new technology. This has been done for a while.

4 JUDGE NAGUMO: Do I understand you to concede the prima
5 facie case of obviousness?

6 MR. POSA: I'm sorry. I can't hear you that well.

7 JUDGE NAGUMO: Do I understand you to concede the prima
8 facie case of obviousness? You are relying on unexpected results?

9 MR. POSA: No, no. I don't concede to a prima facie case of
10 obviousness. I'm not relying on secondary indicia here. I think that we
11 succeed on the merits. Don't get me wrong.

12 I don't see that the two are mutually -- are you saying that the
13 two are mutually exclusive?

14 JUDGE NAGUMO: You mentioned unexpected results and we
15 don't need to consider unexpected results if there is a prima -- unless there's
16 a prima facie case of obviousness.

17 MR. POSA: All right, fine. I understand. No, you don't need
18 to consider. I just wondered if they were mutually exclusive. In other
19 words, whether getting unexpected results precludes overcoming a prima
20 facie case of obviousness when you have other arguments on the merits,
21 which I believe we do here.

22 JUDGE GARRIS: Sir, go ahead and present those arguments
23 now. Just go ahead and present your argument.

24 MR. POSA: Sure, I'm sorry. I'm sorry.

25 The Examiner's initial argument in the Examiner's -- in the final
26 office action is around the middle of page 5 where this two-step process is

1 essentially dismissed, and the Examiner points to the top of column 8 of
2 Duyvesteyn and Winby at column 4, 60 to 64, saying that these things are
3 combined and it would wet the sulfur and attach to bacteria.

4 I'm not going to read those sections for you, but I have read
5 them several times and they simply do not disclose all of the limitations of
6 the claims here.

7 With regard to claim 1, this step of preconditioning, there are
8 words in there that can't simply be overlooked. It is a separate step,
9 preconditioning with bacteria in a biological reactor.

10 Now, I understand it's a method claim, but this takes place
11 someplace other than the heap and it includes a limitation of for sufficient
12 time that the sulfur becomes wetted.

13 Now, the Examiner would like to say that could be any time.
14 This Appellant, this claim -- all of the claims, really, can only be interpreted
15 in light of an extended period of time. I will get to the argument about at
16 least 12 hours. To one of skill in the art, this Appellant is sort of stuck with
17 these claims.

18 I mean, this idea that -- in fact, the Examiner points to one of
19 the references, stating that -- I think it's Duyvesteyn -- that because a mixture
20 can be obtained before, during or after the leaching process in the heap, that
21 would read on this idea of wetting the sulfur particles -- I'm sorry, would
22 read on this wetting of the sulfur particles for a sufficient time to form these
23 bioleach solutions.

24 That's just not true. First of all, the references don't say that.
25 And secondly, the mere fact that it can be done before, during or after
26 clearly precludes the idea of an initial preconditioning step that this

1 Appellant is now bound by in the claim language.

2 I understand that the Examiner's Answer is more robust and
3 cites further sections of both Duyvesteyn and the statutory invention
4 registration, but nevertheless, they don't do any better in terms of teaching
5 these specific limitations found in the claims.

6 If you look to the Examiner's Answer on pages 9 and 10, for
7 example, this idea of 12 to 14 -- 12 to 48 hours on page 9 and on page 10 --
8 and again, we will get to the exact times, but the examiner's response to this
9 idea of leaving it in the form of a solution for the -- prior to the leaching step
10 in the heap, the Examiner states that this an art-recognized result-effective
11 parameter, which have been obvious.

12 There's no support for that. I mean, he doesn't even point to
13 references or case law stating that this would provide the best results.

14 This Appellant did some experiments to determine that this
15 initial preconditioning step has advantages over the prior art and proves it
16 out with examples in the spec.

17 So this idea of sufficient time to produce wetting would be
18 interpreted both for the purposes of patentability and later on, if it were ever
19 needed to be interpreted for the purposes of infringement, I mean, it would
20 have to be interpreted in light of many hours, which the prior art simply does
21 not teach or suggest.

22 Which brings us to the 112s. By my reading, now, if you refer
23 to the Examiner's Answer, there is only a 112 first paragraph remaining for
24 claims 2 and 12 to 14. I mean, I believe that's the status of the claims in
25 terms of the 112 rejections. The 112 second paragraph rejection has been
26 dropped, right?

1 JUDGE GARRIS: That's right.

2 MR. POSA: With regard to claim 2, I'm sure that there is good
3 law on the point about whether you can, whether if you disclose a range
4 where if something is in the range of 1 to 2, can you or can you not say more
5 than 1 or less than 2?

6 I tried to find a case right on point but I couldn't. With regard
7 to claim 2, while we believe that we should be entitled to set forth a
8 limitation like that, given the fact that this specification only discloses 1.8 to
9 2.4, obviously you will be the judges.

10 However, with regard to this idea of 12 to 48 hours, the
11 Examiner only cites certain sections of the specification. I believe we have
12 what you might call a get-out-of-jail-free card on this one.

13 If you look at page 2 of the specification, under the summary, it
14 sets forth that this is a two-step process. In this first step they are reacted for
15 an extended period such as 12 to 24 hours.

16 I believe "such as" gets us out from under the 112 first
17 paragraph rejection. To a person of skill here, what we are saying is that
18 given a time period like this, you can go beyond it. It's just that you'll
19 probably get diminishing returns.

20 In other words, the reaction will have taken its course. There's
21 not much more you could get out of it. I mean, what this is saying, such as
22 12 to 24 hours is sort of saying you have got to heat that up for a long time.

23 I mean, you have got to heat it up for about 6 or 8 hours. When
24 you hear that, heating it up for 10 would be okay. The Examiner says in his
25 argument that this is new matter because at least 12 could be interpreted as
26 30 or 60 or 120.

1 We agree. It absolutely could be interpreted. Because of the
2 word "such as," it means at least 12. That can't really be read any other way.

3 So with regard to claims 12 and 14, which set forth -- I believe
4 it's 12 and 14, yeah -- which set forth at least 12 hours, we think those pass
5 muster under 112 first paragraph.

6 I'd like to just finish with a discussion of some of the other
7 dependent claims. Note that claim 13 for some reason was thrown into the
8 112 first paragraph. But it appears to be a mistake. I mean, there's nothing
9 in there.

10 It's almost like a typo. Instead of a comma, the Examiner used
11 a hyphen. This includes the step of where the solutions produced in the
12 reactor are added to the leaching heap.

13 I don't think this type of claim, apart from the 112 first
14 paragraph rejection, what appears to be a mistake, this shouldn't be
15 overlooked. I mean, this is a further refinement of the fact that there's a
16 transfer step that takes place.

17 The first step occurs in a reactor, not in the heap. This is
18 important. And then it is taken from there and put into the heap. The
19 Examiner also has a rejection of claim 13 on the merits, page 10 of the
20 Answer.

21 The Examiner states that this is suggested by Duyvesteyn where
22 the -- at column 7 lines 52 to 55, I urge you to read it because it's -- all he's
23 talking about is churning the heap. That portion of the prior art states that
24 this solution can be collected at the bottom and recycled to the top.

25 That has nothing to do with taking a solution from point A and
26 putting it in point B in two different places. The Examiner uses the same

1 argument, by the way, to reject claim 9, dependent claim 9, which has
2 entirely different limitations. So that section of Duyvesteyn does not apply
3 to either in our opinion.

4 I understand that the brief made separate issues out of the
5 dependent claims and sometimes that appears to be heavy-handed or
6 whatever, unreasonable, but in this case, it makes a lot of sense.

7 If you look at the rejections of the dependent claims, which
8 really takes place only in the Examiner's Answer in any substantive way,
9 you'll find that they should not be rejected for the reasons presented.

10 I will just leave you with the rejection of claim 4, for example,
11 dependent claim 4, which is discussed on page 8 of the Examiner's Answer.
12 Claim 4 has multiple limitations. First of all, it is dependent on claim 3, it
13 has how many kilograms of sulfur water milled in a liter of water for a
14 certain percentage of mesh fineness.

15 The examiner simply states that rod milling is known in the art
16 without any other expected result. That's not a very comprehensive
17 rejection.

18 That's all I have unless you have some questions for me.

19 JUDGE GARRIS: Judge Gaudette, any questions?

20 JUDGE GAUDETTE: No.

21 JUDGE GARRIS: Judge Nagumo?

22 JUDGE NAGUMO: No questions.

23 JUDGE GARRIS: No questions, sir. Before you leave,
24 however, for our court reporter, would you please give and spell your name
25 for her.

26 MR. POSA: Sure. John, middle initial G, last name Posa, P-O-

1 S-A.

2 JUDGE GARRIS: Thank you very much for discussing this
3 appeal with us.

4 MR. POSA: Thank you. You, too.

5 Whereupon, the proceedings at 9:13 a.m. were concluded.